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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/787,157 | 03/14/2001 | Mikihiro Endo | 55710 | 6514 |

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Peter F. Corless
Edwards & Angell, LLP
P.O. Box 9169
Boston, MA 02209

EXAMINER

CHANG, VICTOR S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1771

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DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/787,157

Applicant(s)

ENDO ET AL.

Examiner

Victor S Chang

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

NOTE

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07026212 A (Abstract and newly cited English translation by computer) either individually, or in view of JP 11021519 A (Abstract), substantially for the reasons set forth in section 4 of Paper No. 3, together with the following additional observations.

With respect to the newly provided computer translated English version of JP '212, it is noted that the translated full version provides further details of JP '212, such as: 1) The amount of titanium oxide in the outer polyolefin layer changes with the thickness of the film, e.g., 0.25 wt% or more is required for film with thickness of 100 μm , and 0.5 wt% or more for film with thickness of 50 μm , etc. (see [0011] of translated version of JP '212); further, in Example, JP '212 teaches that a master batch with 10 wt% of titanium oxide is prepared for the outer layer (see [0025]). 2) The thickness of the polyolefin layer appears to be 20 μm , polyolefin layer of 10 μm , the tie layer is 5 μm , and the adhesive layer is 10 μm ([0026]).

With respect to Applicants' Response arguing that JP '212 teaches a block copolymer which requires acid treatment/modification, whereas Applicants' pressure sensitive adhesive "can be manufactured inexpensively with reduced manufacturing process, since no anchor coat treating procedure is required" (Response, page 3, second paragraph), the Examiner would like to point out that manufacturing cost bears virtually no weight in the determination of the patentability of an article. Further, the previously cited as evidence of the state of the art EP '425 (third paragraph on page 2 of

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Paper No. 5) clearly discloses that a tie layer (which the Examiner notes is not expressly claimed by Applicants as their "layer C") for polyolefin layers may be a random, diblock or triblock of styrene and butadiene copolymer, which is free of acid modification. As such, it is within the ordinary skill in the art to replace an acid modified block copolymer of JP '212 with a random copolymer, as taught by EP '425, motivated by the desire to reduce the manufacturing cost. The Examiner would like to emphasize that both acid modified and unmodified random or block adhesive polymers for use as a tie layer in a multilayer polymer film is old and well known.

With respect to Applicants' argument that JP '212 and JP '519 fail to teach the specific amount by weight of the tie layer (Response, page 5, second complete paragraph), it is believed that the determination of a suitable amount of a tie layer in a multilayer film structure is at most an obvious optimization of adhesion properties to one of ordinary skill in the art.

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
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